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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,810	11/23/2000	Brad A. Miller	P001US	3597

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,810

Applicant(s)

MILLER, BRAD A.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

The instant application has been filed with claim pages 16-18 wherein page 18 contains the same claims 1-7 that appear on page 16 and therefore duplicate claims 1-7 of page 16. Applicants are required to cancel one page containing the same claims.

The disclosure is objected to because of the following informalities: The symbol for degree "⁰" is missing after "402) on page 9, line 15 and page 13, line 1, after "73.5" on page 9, line 16 and page 13, line 2 after "175" on page 3, line 17, and after "240" on page 3, line 18. The symbol "⁰F" is missing before "347" on page 3, line 17 and before "400" on page 3, line 18. There are two pages of claims 1-7, page 16 and 18. Applicants are required to cancel one page of the same set of claims.

Appropriate correction is required.

Claims 2-4, 6-7, 11-13, 15-16 and 18 are objected to because of the following informalities: The symbol for degree "⁰" is missing after "410" in line 2 claims 2, 6, 11 and 15, after "402" in line 2 of claims 3, 7, 12 and 16 and after "7.35" in line 2 of claims 4, 8 and 13.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 9-16 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The formulation comprising greater than 95

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percent aliphatic hydrocarbons, wherein said aliphatic hydrocarbons comprises a mixture (a) between 13-23 weight percent aliphatic petroleum naphtha; (b) between 17 and 25 percent aliphatic petroleum distillates; and (c) between 5 and 10 percent petroleum base oil, wherein said mixture have a boiling point between 390 and 410⁰ F, a specific gravity between 0.7 and 0.75, and water insolubility, and a method for the preservation of a film print comprising said formulation is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure set forth on page 3, lines 9-22 indicate that said features were considered essential by applicants, are not set forth in the instant claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (and its dependent claims) is indefinite for failing to set forth the relative proportion of (a), (b) and (c), the boiling point, specific gravity, the insolubility in water of said mixture, and the relative proportion of aliphatic hydrocarbons in the said formulations, and in the method for the preservation of a film print. Claims 2-3, 5-7, 11-12 and 15-16 are indefinite for the inconsistency between the degree in Fahrenheit and the degree in centigrade in Centigrade in claims 4, 8 and 13. It is suggested that applicants should be consistent throughout the claims with respect to the degrees in the

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said claims. Claim 9 (and its dependent claims) is indefinite and confusing for the formulation in that it is unclear as to how to ascertain the scope of protection that applicant is intended to encompass as the claimed invention. Claims 9 (and its dependent claims) is indefinite for failing to recite the relative proportion for said naphtha, distillates and base oil. Claim 14 (and its dependent claims) is indefinite for failing to set forth the relative proportion of the naphtha, distillates and base oil, and failing to set forth the step for providing the film for the coating to be coated. Claims 9 and 14 are indefinite for failing to set forth the boiling point, specific gravity, and insolubility in water. Claims 10-13 and 1-4 are indefinite in that the latter claims are duplicated by claims 10-13. Applicants should delete one set of claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nair et al (Nair) 5,786,134 in view of Nicholas et al (Nicholas) 5,462,459, Stowell 5,443,604, Booser's Handbook of Lubrication and Schey's Tribiology in Metal-working "Friction, Lubrication and Wear".

Nair teaches a topcoat including a lubricating agent, e.g. paraffin, for print film, for preservation abstract, column 7, lines 36-39 and 49 and column 8, lines 45-51. Nair further teaches a method for applying the topcoat to a film, column 10, lines 24-25 and 63-67.

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Nair is silent to the composition of the paraffin. It would be obvious to the artisan to prepare and use a formulation comprising a mixture of aliphatic petroleum naphtha, aliphatic petroleum distillates and petroleum base oil in view of Nicholas, Stowell, Booser and Schey.

Nicholas teaches a wood preservative composition comprising a solvent/dilutant that may be liquid petroleum hydrocarbons and distillates including aromatic and aliphatic hydrocarbons such as mixtures of xylene, toluene, naphtha, light mineral oil, column 5, lines 25-33.

Stowell teaches and discloses a polishing compound for plastic surface comprising lubricant and mineral spirits of blend of 9 wt % of heavy naphthenic distillates and 0-63wt.% of heavy aliphatic solvents, and petroleum distillates of mineral minerals, column 3, lines 5-15 and column 4, lines 23-63.

Booser is relied on as a teaching reference for teaching the state of the art knowledge at the time of the claimed invention. Booser teaches that petroleum-based "mineral" oils are the most common liquid lubricants. Minerals oils are composed mostly of paraffinic, naphthenic (cyclic paraffin) and aromatic hydrocarbon groups linked in a mixture of complex molecules, page 53 and page 54 for figure 3. Naphthenic oils are most common having low viscosity index, low temperature fluidity. A base oil viscosity range of 65 to 175 cSt at 40⁰C is the most widely used. The two main classes of petroleum base oils are parafinic and naphthenic. The paraffinic oils are poorer solvents for many additives, page 260.

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Schey is relied on as a teaching reference for teaching the state of the art knowledge at the time of the claimed invention. Schey teaches various properties for paraffinic oils and naphthenic oils, pages 133-136 and 138.

It would be obvious to the artisan in the art to select a mixture of aliphatic hydrocarbons of the secondary references as the paraffin lubricant and carriers preservative formulation for the topcoat composition of Nair for print film preservative because the solvent mixture is a conventional combination for preservative formulation. It is the examiner's position that the boiling point, specific gravity and vapor pressure characteristics of the instant claims would be the same in the secondary references because the combination of solvent in the same relative proportions are the same, especially in view of the teachings of the secondary references Stowell that the solvent composition have similar viscosity, volatility and lubricating properties col. 8, lines 18-25. The pending claims are not commensurate in scope with the experimental data set forth in Example 1, and the data cannot be relied upon to rebut the rejection made of record.

The prior art cited but not applied further teaches aliphatic hydrocarbons and print film comprising additives of the same nature as claimed by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER

M. B. Medley/mn
October 15, 2002